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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/673,520	10/17/2000	Heiko Dassow	2345/137	6699
26646	7590	03/20/2006	EXAMINER	
KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004			NGUYEN, HANH N	
			ART UNIT	PAPER NUMBER
			2668	

DATE MAILED: 03/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/673,520

Applicant(s)

DASSOW ET AL.

Examiner

Hanh Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on RCE filed on 2/27/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.



HANH NGUYEN
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/13/01.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 11, is “the user information on at least one second section of digital network” on line 8 coded with another coding scheme ?

Claims 12-22 are rejected because they depend on claim 11 respectively.

Claim Objections

Claim 22 is objected to because of the following informalities: “and/or” on line 3 is not clearly defined. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting

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directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 11-21 are rejected under 35 USC 102(e) as being anticipated by Henderson et al. (US pat. 6,493,355 B1).

In claim 11, Henderson et al. discloses, in fig. 1, a method for reducing bandwidth (reducing transmission rate from 64 Kbps to 32 Kbps; see col.5, lines 55-65) when transmitting data (transmitting voice call) between a sending terminal (fax calling device 102) and a receiving terminal (fax answer device 104) over a voice connection path (analog connection 108) using a digital data network (ATM or IP network 116; see col.4, lines 25-30) comprising: converting, within the digital data network, a coding of user information between a data transmission in the voice connection path and a data transmission in the digital data network (see col.5, lines 55-65; I/F 114 of ATM switch 110 configured to convert voice call from one data coding to another different data coding such as PCM voice call is converted from 64 Kbps to 32 Kbps) so as to transmit the user information via the coded voice connection path on at least one first section of the digital data network (col.6, lines 2-14; ATM switch 110 generates ATM cells for transmission through ATM network 116) and transmit the user information (transmit the voice call) by a method suitable for the digital data network on at least one second section of the digital data network (see col.5, lines 15-28; analog voice call from calling device 102 to C.O. 106 is converted into digital data for suitable transmission in accordance with a digital transmission scheme).

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In claim 21, Henderson et al. discloses user information to be transmitted conforms to features of FAX class 3 (calling device 102 and answer device 104 are FAX machines that transmit faxes). See col.4, lines 45-55.

In claim 20, Henderson et al. discloses digital data network includes an interconnection of a plurality of individual data networks (ATM network 116 may be combined with any number of communication systems) see col.4, lines 35-42.

In claim 19, Henderson discloses at least one of the sending and receiving terminals (devices 102 and 104) is connected via digital lin to digital data network (ATM networ 116) to avoid a need to first code the data using either sending or receiving terminal for transmitting over the voice connection and decode the coded data (as stated above, other than calling device 102 and answer device 104, C.O switch 106 digitizes voice call; I/F 114 converts the digitized voice from one coding scheme to another coding scheme).

In claim 18, Henderson et al. discloses splitting user information into data packet for transmitting over the digital data network (the system uses ATM or IP network for transmitting voice call; therefore, it is a well-known skills in the art that packets are transmitted through ATM or IP network 116; see col.4, lines 25-30), a transmission rate of data packets being flexibly adapted at a network transition to a bit rate transmitted by the sending terminal (See fig.3; a plurality of coding schemes are selected for converting at I/F 114 so that bandwidth is dynamically allocated for incoming voice call).

In claim 13, Henderson et al. discloses no special function matching of the sending and receiving terminals is required for the converting (as stated above, I/F 114

and I/F 120 of ATM network 116 converts the coding of voice call other than calling device 102 and 104; see col.5, lines 55-65 and col.6, lines 5-20).

In claim 12, Henderson et al. discloses a similar modulation method is used by sending and receiving terminals for transmitting data over voice connection path (fig.3, call analyzer 302 may operate with different modulation schemes which inherently includes similar modulation method). See col.8, lines 45-50.

In claim 14, the limitation of this claim has been addressed in claim 11.

In claim 15, Henderson et al. discloses transmitting the user information via the coded voice connection is performed automatically by a context-related call number translation during a connection setup (a facsimile modem call is prompted automatically by itself). See col.4, line 65 to col.5, line 5.

In claim 16, as disclosed in claim 11, performing end-to-end signalling on at least one section of digital network between sending and receiving terminals are well-known in the art.

In claim 17, Henderson et al. discloses the sending and receiving terminals (devices 102 and 104) use different respective data transmission processes (uses different codings in response to different type of data; see col.6, lines 60-65) and temporary storing the transmitted data (fig.2, memory 206 stores information ; see col.7, lines 35-45) so as to match the respective data transmission processes of the sending and receiving (this limitation has been addressed in claim 11) terminals such that the differences in the transmission processes are not perceived by the sending and the receiving terminals.

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 22 is rejected under 35 USC 103(a) as being unpatentable over Henderson et al. (US pat. 6,493,355 B1) in view of Mauro (US pat. 7,003,114 B1)

In claim 22, Henderson et al. does not disclose protecting the data by cryptographic processes against passive monitoring, alteration or alteration incorrect call data or contents. Mauro discloses a transmitter 100 (fig.1) having an encryption mode 108 that encrypts voice information using unique code in order to protect security (see col.3, lines 60-67 and col.4, lines 35-40 and col.7, lines 40-55). Therefore, it would have been obvious to one ordinary skilled in the art use the cryptographic security technique of Mauro into system 100 of Henderson et al. to protect voice security before transmitting via a digital data network. The motivation is to protect data security during transmission.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ahler et al. (US pat. 6,552,826 B2) ; and Henderson et al. (US Pat. 6,683,888B1).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hanh Nguyen whose telephone number is 571 272 3092.

The examiner can normally be reached on Monday-Friday from 8:30 to 4:30. The

examiner can also be reached on alternate

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi Pham, can be reached on 571 272 3179. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hanh Nguyen
Primary Examiner



HANH NGUYEN
PRIMARY EXAMINER